

Remarks

Applicants have canceled claims 1-21 without prejudice or disclaimer. New claims 22-41 have been added in order to claim additional embodiments of the subject matter of the provisionally-elected group. New claims 22-41 find support throughout the specification and claims as originally filed, and thus no new matter has been added.

Claims 22-41 are pending.

The Restriction Requirement

Pursuant to the paper mailed April 13, 2004, the Examiner has required an election under 35 U.S.C. §§ 121 and 372 of one of Groups I-III. The Examiner contends that the inventions or groups of inventions are not so linked as to form a single general inventive concept under PCT Rule 13.1. The Examiner has further required an election under 35 U.S.C. §§ 121 and 372 of one of SEQ ID NOS.1-155, stating that "each of the nucleic acids SEQ ID NO:1-155 encode for a separate protein." Applicants note that by discussing PCT Rule 13 and "the special technical feature," the Examiner has implicitly recognized that this national stage application must be examined under unity of invention principles, not under normal U.S. restriction practice.

Applicants point out that contrary to the Examiner's statement, each SEQ ID refers to a contig, which includes numerous ORFs each encoding for a separate protein. *See, e.g.*, page 6, line 20 to page 7, line 32, and page 15, line 11 to page 18, line 26. Thus, as the Examiner appears to be attempting to require restriction to a polynucleotide encoding a single protein, Applicants will presume that the Examiner intended to require restriction to a single ORF within a SEQ ID NO as disclosed in the Tables, not to a single SEQ ID NO (which would include multiple ORFs).

Accordingly, Applicants provisionally elect, *with traverse*, the invention of Group I represented by originally filed claims 1-8, 14, and 18-19, and new claims 22-41, drawn to nucleic acids, for further prosecution. Applicants further provisionally elect, *with traverse*, the nucleic acid sequence of ORF ID 1 of Contig ID 51, represented by nucleotides 984 to 2066 of SEQ ID NO:51. Applicants reserve the right to file one or more divisional applications directed to non-elected inventions should the restriction requirement be made final. Applicants point out that claims 1-21 have been canceled without prejudice or disclaimer, and that new claims 22-41 are directed to subject matter falling within the ambit of Group I (and a single ORF) as cast by the Examiner.

With respect to the Examiner's division of the invention into three groups and the reasons stated therefore, Applicants respectfully disagree and traverse. In particular, Applicants

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assert that Groups I and II are linked so as to form a single general inventive concept under PCT Rule 13.1, and thus should be examined together. MPEP Appendix AI (the PCT Administrative Instructions) explicitly recognizes that unity of invention exists between a protein and the DNA sequence encoding that protein:

Example 17

Claim 1: Protein X

Claim 2: DNA sequence encoding protein X.

Expression of the DNA sequence in a host results in the production of a protein which is determined by the DNA sequence. The protein and the DNA sequence exhibit corresponding special technical features. Unity between claims 1 and 2 is accepted.

MPEP Appendix AI, at AI-60 (emphasis added). *See also* MPEP § 1850 at 1800-61 (accepting the examples in Annex B of the Administrative Instructions as examples of unity of invention). Thus, the Examiner's assertion on page 3 of the Office Action that the inventions of Groups I and II do not relate to a single general inventive concept directly conflicts with the established rules for unity of invention practice. At the very least, unity of invention exists between Groups I and II of the present invention, and those groups must be examined together. *See* PCT Article 27(1) ("No national law shall require compliance with requirements relating to the form or contents of the international application different from or additional to those which are provided for in this Treaty and the Regulations.")

Accordingly, in view of MPEP § 1850, MPEP Appendix AI, PCT Article 27(1), and PCT Rule 13.1, Applicants submit that the instant restriction requirement does not comply with PCT Rule 13.1 regarding unity of invention. Applicants therefore respectfully request that the restriction requirement under §§ 121 and 372 be reconsidered and rewritten or withdrawn.

Applicants retain the right to petition from the restriction requirement under 37 C.F.R. § 1.144.

Conclusion

Entry of the above amendment is respectfully solicited. The Examiner is invited to call the undersigned at the phone number provided below if any further action by Applicants would expedite the examination of this application.

If there are any fees due in connection with the filing of this paper, please charge the fees to our Deposit Account No. 08-3425. If a fee is required for an extension of time under 37

C.F.R. § 1.136, such an extension is requested and the appropriate fee should also be charged to our Deposit Account.

Dated: May 13, 2004

Respectfully submitted,

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CERTIFICATE OF TRANSMISSION UNDER 37 C.F.R. § 1.8

1. Fax Cover Sheet
2. Fee Transmittal Sheet
3. Provisional Election Under 37 C.F.R. § 1.143 With Traverse And Amendment Under 37 C.F.R. § 1.111

I hereby certify that the above-listed correspondence is being facsimile transmitted to the United States Patent and Trademark Office on May 13, 2004.



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